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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/271,247	03/17/1999	MAKOTO SATOH	35.C13405	3843
5514	7590	02/25/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			MISLEH, JUSTIN P	
			ART UNIT	PAPER NUMBER
			2612	

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/271,247

Applicant(s)

SATO, MAKOTO 

Examiner

Justin P Misleh

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 - 48 is/are pending in the application.
- 4a) Of the above claim(s) 1 - 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25 - 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 October 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Note to the Applicant

The Examiner authoring this Office Action is newly assigned to the present application.

Response to Arguments

1. Applicant's arguments filed 13 September 2004 have been fully considered but they are not persuasive.
2. Initially, the Applicant states, "however, as acknowledged by the Examiner, [Yamada et al.] fails to disclose or suggest at least the feature wherein transfer means transfer information of priority order of image data, and reception means which receives the information of priority order of the image data." Furthermore, the Applicant adds that, "[Yamada et al.] further fails to disclose or suggest ... in which information of priority order is added to a file, such as an image tile or the like, and the thus obtained file is transmitted to a reception-device, whereby an operator on the reception-device can select the file based on the intention of the operator of the transmission-side device ... claimed in the present application."
3. In regards to Satoh et al., the Applicant repeats, as discussed in regards to Yamada et al., that, "[Satoh et al.] fails to disclose or suggest ... that information of priority order is added to a file, such as an image tile or the like, and the thus obtained file is transmitted to a reception-device, whereby an operator on the reception-device can select the file based on the intention of the operator of the transmission-side device ... claimed in the present application."
4. In response to Applicant's arguments against Yamada et al. in view of Satoh et al., the Examiner submits that "information of priority order is added to a file, such as an image tile or

Art Unit: 2612

the like, and the thus obtained file is transmitted to a reception-device, whereby an operator on the reception-device can select the file based on the intention of the operator of the transmission-side device”, is not specifically claimed in Claims 29 and 36 as alleged by the Applicant; hence, Applicant’s argument regarding Yamada et al. and Satoh et al. are moot.

5. In conclusion, Applicant's arguments amount to a general allegation that Claims 29 and 36 define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Although the claims interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Specification

6. The abstract of the disclosure is objected to because of its length, which exceeds 150 words.

Correction is required. See MPEP § 608.01(b).

7. The disclosure is objected to because of the following informalities: minor typographical errors.

- On page 30 (line 23), the specification states, “(S81);” however, upon further consideration it should be changed to “(S91)”.

Appropriate correction is required.

Drawings

8. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: S93 and S94.

Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the Examiner, the Applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 25 – 27, 30, 33 – 38, 41, and 44 – 46** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. (US 6 515 697 B1) in view of Satoh et al. (US 6 111 662).

11. For **Claim 25**, Yamada et al. disclose an image transmission apparatus comprising:

Art Unit: 2612

transfer means for transferring data amount information indicating the amount of target image data to an external apparatus (auxiliary memory MC; see col. 6 line 61 - col. 7 line 18; col. 8 line 58 - col. 9 line 40; col. 10 line 1 - col. 11 line 3; col. 11 line 31 - col. 12 line 19);

reception means for receiving from said external apparatus (MC) a response signal indicating whether or not said external apparatus admits of the transmission of said image data in accordance with said information of data amount and the free storage capacity of storage means to store said image data in said external apparatus (col. 6 line 61 - col. 7 line 18; col. 8 line 58 - col. 9 line 40; col. 10 line 1 - col. 11 line 3; col. 11 line 31 - col. 12 line 19); and

control means (MPU1 & MPU2) for controlling the transmission of said image data in accordance with the response signal received by said reception means to indicate whether or not the transmission of said image data is admitted (col. 6 lines 16-27; col. 10 line 1 - col. 11 line 3; col. 11 line 31 - col. 12 line 58).

Claim 25 differs from Yamada et al. in that the claim further requires the transfer means transfers information of priority order of the image data, and the reception means receives the information of priority order of the image data. However the claimed limitation is well known in the art as shown in Satoh et al.

In the same field of endeavor, Satoh et al. teach an electronic imaging apparatus (camera 30A/B) (see Figs. 1&2) comprising transfer means (modem 40A/B) for transferring the information of data amount indicating the data amount of image data to an external apparatus (see Fig. 9), and reception means for receiving from said external apparatus (camera 30A/B) a response signal indicating whether or not said external apparatus admits of the transmission of said image data in accordance with said information of data amount and the free storage capacity

Art Unit: 2612

of storage means to store said image data in said external apparatus (see Figs. 15-22) (col. 9 line 65 – col. 10 line 62; col. 12 line 32 – col. 13 line 52). Satoh et al. further teach that the transfer means transfers information of priority order of the image data, and the reception means receives the information of priority order of the image data (see Figs. 27-28 and 33; col. 18 line 47 – col. 20 line 32).

In light of the teaching in Satoh et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the digital camera taught in Yamada et al. by transferring and receiving the information of priority order of the image data so as to inform the user of the specific image data which have been transferred and received.

12. As for **Claim 26**, Yamada et al. disclose that the response signal to indicate whether or not the transmission of said image data is admitted is generated by the manual operation of said external apparatus (Yamada teaches that upon detection of the insertion of the auxiliary memory MC, the control means causes the image data in the main memory (MM) to be transferred and copied to the auxiliary memory MC according to designation of a copy mode; col. 1 lines 50-64, col. 7 lines 26-32, 36-39).

13. As for **Claim 27**, Yamada et al. disclose that said image transmission apparatus is a digital camera (see Fig. 4, col. 1 lines 12+).

14. As for **Claim 30**, Yamada et al. disclose the image corresponding to said image data is the image corresponding to a plurality of files, and said response signal to indicated whether or not the transfer of said image data is admitted permits the transfer of a part of plural files, but not any transfer of the files other than the part of the file permitted for transfer (col. 6 line 41 - col. 7 line 32; col. 8 line 13 - col. 9 line 40; col. 10 line 1 - col. 11 line 42).

Art Unit: 2612

15. As for **Claim 33**, Yamada et al. disclose that the digital camera is capable of photographing during the transmission of said image data (col. 7 lines 60-64; col. 9 lines 58-67; col. 12 lines 20-58).

16. As for **Claim 34**, Yamada et al. disclose means for designating the suspension of the communication (col. 2 lines 4-12; col. 12 line 20 - col. 13 line 30; col. 14 lines 17-26).

17. As for **Claim 35**, Yamada et al. disclose the image corresponding to said image data is the image corresponding to a plurality of files, and said reception means receives from said external apparatus the information indicating the files to be received by said external apparatus, and the information indicating the address of the external apparatus other than said external apparatus, the files to be received by the external apparatus other than said external apparatus (col. 2 lines 4-12; col. 6 line 41 - col. 7 line 32; col. 8 line 13 - col. 9 line 40; col. 10 line 1 - col. 11 line 42; col. 12 line 20 - col. 13 line 30).

18. For **Claim 36**, Yamada et al. disclose an image reception apparatus comprising:

reception means (MPU2) to receive a transfer including the information of data amount indication the data amount of image data, from an external apparatus (auxiliary memory MC);

detection means to detect the free storage capacity of storage means to store said image data (col. 6 line 61 - col. 7 line 18; col. 8 line 58 - col. 9 line 40; col. 10 line 1 - col. 11 line 3; col. 11 line 31 - col. 12 line 19);

output means to output the indication screen to indicate the reception of said image data in accordance with said information of data amount and said free storage capability (see Figs. 6-9 and 11);

transmission means to transmit to said external apparatus (MC) the signal to indicate whether or not said image data are required in accordance with the reception indication of said image data (col. 6 line 61 - col. 7 line 18; col. 8 line 58 - col. 9 line 40; col. 10 line 1 - col. 11 line 3; col. 11 line 31 - col. 12 line 19); and

image reception means to transmit to said external apparatus (MC) the signal to said external apparatus (col. 6 line 61 - col. 7 line 18; col. 8 line 58 - col. 9 line 40; col. 10 line 1 - col. 11 line 3; col. 11 line 31 - col. 12 line 19).

Claim 36 differs from Yamada et al. in that the claim further requires the external apparatus is admitted to the transmission of said image data, and the image reception means is to receive the image data transmitted by said external apparatus in response to the signal transmitted by said image reception means. Claim 36 also differs from Yamada et al. in that the claim further requires the transfer means transfers information of priority order of the image data, and the reception means receives the information of priority order of the image data. However the claimed limitation is well known in the art as shown in Satoh et al.

In the same field of endeavor, Satoh et al. teach an electronic imaging apparatus (camera 30A/B) (see Figs. 1&2) comprising transfer means (modem 40A/B) for transferring the information of data amount indicating the data amount of image data to an external apparatus (see Fig. 9), and reception means for receiving from said external apparatus (camera 30A/B) a response signal indicating whether or not said external apparatus admits of the transmission of said image data in accordance with said information of data amount and the free storage capacity of storage means to store said image data in said external apparatus (see Figs. 15-22) (col. 9 line 65 – col. 10 line 62; col. 12 line 32 – col. 13 line 52). Satoh et al. further teach that the transfer

Art Unit: 2612

means transfers information of priority order of the image data, and the reception means receives the information of priority order of the image data (see Figs. 27-28 and 33; col. 18 line 47 – col. 20 line 32).

In light of the teaching in Satoh et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the digital camera taught in Yamada et al. by transferring and receiving the information of priority order of the image data so as to inform the user of the specific image data which have been transferred and received.

19. As for **Claim 37**, Yamada et al. disclose that the signal to indicate whether or not the transmission of said image data is admitted is generated by the manual operation of said output means (Yamada teaches that upon detection of the insertion of the auxiliary memory MC, the control means causes the image data in the main memory (MM) to be transferred and copied to the auxiliary memory MC according to designation of a copy mode; col. 1 lines 50-64, col. 7 lines 26-32, 36-39).

20. As for **Claim 38**, Yamada et al. disclose that said image transmission apparatus is a digital camera (see Fig. 4, col. 1 lines 12+).

21. As for **Claim 41**, Yamada et al. disclose the image corresponding to said image data is the image corresponding to a plurality of files, and said signal to indicated whether or not the transfer of said image data is admitted permits the transfer of a part of plural files, but not any transfer of the files other than the part of the file permitted for transfer (col. 6 line 41 - col. 7 line 32; col. 8 line 13 - col. 9 line 40; col. 10 line 1 - col. 11 line 42).

Art Unit: 2612

22. As for **Claim 44**, Yamada et al. disclose that the digital camera is capable of photographing during the transmission of said image data (col. 7 lines 60-64; col. 9 lines 58-67; col. 12 lines 20-58).

23. As for **Claim 45**, Yamada et al. disclose means for designating the suspension of the communication (col. 2 lines 4-12; col. 12 line 20 - col. 13 line 30; col. 14 lines 17-26).

24. As for **Claim 46**, Yamada et al. disclose the image corresponding to said image data is the image corresponding to a plurality of files, and said reception means receives from said external apparatus the information indicating the files to be received by said external apparatus, and the information indicating the address of the external apparatus other than said external apparatus, the files to be received by the external apparatus other than said external apparatus (col. 2 lines 4-12; col. 6 line 41 - col. 7 line 32; col. 8 line 13 - col. 9 line 40; col. 10 line 1 - col. 11 line 42; col. 12 line 20 - col. 13 line 30).

25. **Claims 28 and 39** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. in view of Satoh et al. in further view of Oie (US 6 188 431).

26. As for **Claims 28 and 39**, the claims differ from Yamada et al. in view of Satoh et al., in that they further require that said transfer means and said reception means perform transfer and transmission by use of cordless line. However, it is well known in the art to transfer image data of a digital camera using cable or cordless line, as taught in Oie (see col. 2 lines 25-27, col. 7 lines 34+).

In light of the teaching from Oie, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the image transmission apparatus taught in

Art Unit: 2612

Yamada et al. in view of Satoh et al. the capabilities of transmitting image data by use of cordless line so as to allow the user freedom to conveniently capture and transmit image data without using a cable.

27. **Claims 29, 31, 32, 40, 42, and 43** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. in view of Satoh et al. in further view of Murphy et al. (US 6 282 362).

28. As for **Claims 29, 31, 32, 40, 42, and 43**, the claim differs from Yamada et al. in view of Satoh et al., in that it further requires said transfer means performs transfer by adding the thumbnail images having a file name corresponding to said image data, wherein said file name indicated the positional information when said image data is photographed, and said transfer means transfers the audio corresponding to said image. The limitations are well known in the art as shown in Murphy et al.

In the same field of endeavor, figure 2 of Murphy et al. teaches a digital camera system 300 comprising a camera body (310), a recording unit (370) and a playback unit (380). Murphy et al. further teach that the thumbnail image having file names indicated the positional information of the photographed image data can be displayed on the camera viewer (340; see Fig. 1, playback unit 104 comprises index image 184 and index icon generator 190). Murphy et al. further teaches that audio streams can be digitally stored and play backed via the audio pickup device (172) and an audio transducer (202; see Fig. 1).

In light of the teaching from Murphy et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the image transmission apparatus

Art Unit: 2612

taught in Yamada et al. in view of Satoh et al. the capabilities of adding the thumbnail images having audio data and file name indicating the positional information of the photographed image so as to provide image data storage in digital format with hype-links between the image and the image location at the time of data capture.

29. **Claims 47 and 48** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. in view of Satoh et al. in further view of Fukuoka (US 6 300 976).

30. As for **Claims 47 and 48**, the claims differ from Yamada et al. in view of Satoh et al. in that it further requires the response signal includes information, which designates a terminal station other than said external apparatus as a transmission destination of the image data to be transmitted. The limitation is well known in the art as shown in Fukuoka.

In the same field of endeavor, Fukuoka teaches a digital image capturing device comprising an I/O card (15) which can store digital images, audio information and codes allowing a plurality of cameras and controllers to be connected through a network (col. 2 line 60 - col. 3 line 49; col. 4 lines 3-34; col. 6 line 55 - col. 7 line 15; col. 10 lines 31+).

In light of the teaching from Fukuoka, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the digital camera taught in Yamada et al. in view of Satoh et al. by including in the response signal information designating a terminal station as a transmission destination allowing digital images to be efficiently transferred to a plurality of cameras and controllers through a network.

Conclusion

31. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Justin P Misleh whose telephone number is 703.305.8090 (571.272.7313 ~ March 2005). The Examiner can normally be reached on Monday through Thursday from 7:30 AM to 5:00 PM and on alternating Fridays from 8:00 AM to 4:30 PM.


If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Wendy R Garber can be reached on 703.305.4929. The fax phone number for the organization where this application or proceeding is assigned is 703.872.9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 2612

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JPM
February 22, 2005


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